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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,807	05/01/2001	Erich Selna	2079.000800/P6287	5875

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EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
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2181

DATE MAILED: 09/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,807

Applicant(s)

SELNA ET AL.

Examiner

Khanh Dang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 16-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16-21 are directed to an apparatus. However, the essential structural cooperative relationships between elements in the claims have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11-19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by MacLeod et al.

At the outset, it is first noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure that differs from MacLeod et al. With regard to claims 1 and 16, MacLeod et al. discloses a computer system, comprising a primary chassis (housing of PC 60); a primary device (PC 60) having a bus for carrying electrical signals, wherein the primary device (PC60) is disposed in the primary chassis (housing of PC60); a secondary chassis (housing of peripheral device 50); and an external device (peripheral device 50) having a bus for carrying electrical signals, wherein the external device (50) is disposed in the secondary chassis (housing of peripheral device 50) and the external device bus is directly electrically interconnected with the primary device bus so that the electrical signals carried on the primary device bus are transmitted to the external device bus and the electrical signals carried on the external device bus are transmitted to the primary device bus. With regard to claim 2, as in any PC, it is inherent that PC 60 includes a motherboard. With regard to claim 3, it is clear from MacLeod et al. that peripheral device 60 is a device selected from the group consisting of a storage medium, a graphics processor, and a sound processor. With regard to claims 4 and 17, the hub 10 is readable as a bridgeboard capable of directly electrically interconnecting the primary device bus and the external device bus. With regard to claim 5, it is first noted that it has been held that the recitation is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In any event, it is clear that the hub 10 or bridgeboard comprises a bridge chip capable of receiving signals from the primary device bus and repeating the signals over the external device bus and is

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capable of receiving signals from the external device bus and repeating the signals over the primary device bus. With regard to claims 6 and 18, it is first noted that it has been held that the recitation is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In any event, it is clear that the hub 10 is capable of receiving the signals from the primary device bus at a first transmission speed (from host to hub 10, for example) and is capable of repeating the signals over the external device bus at a second transmission speed (either USB, IEEE 1394, SCSI, PCI I/F, PCMCIA, or IRDA speed, for example), and wherein the hub 10 is capable of receiving the signals from the external device bus at a second transmission speed (either USB, IEEE 1394, SCSI, PCI I/F, PCMCIA, or IRDA speed, for example) and is capable of repeating the signals over the primary device bus at the first transmission speed (from hub to host, for example). With regard to claims 7 and 19, it is first noted that it has been held that the recitation is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In any event, it is clear that host 10 is capable of translating electrical signals from a first signal protocol to a second signal protocol (either USB, IEEE 1394, SCSI, PCI I/F, PCMCIA, or IRDA protocol, for example). With regard to claim 8, it is clear that the primary device bus of MacLeod et al. is a high-speed processor bus. With regard to claim 9, it is clear that the external device bus of MacLeod et al. is a high-speed processor bus (USB 2.0, for example). With regard to claims 11 and 21, as in any PC housing, it is inherent that the

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housing of PC 60 includes cooling device such as heatsink or fans. It is also inherent that the video driver (card) of external device 50, as to any conventional video card, is provided with either a passive heatsink or an active fan. With regard to claims 12-15, it is clear that one using the apparatus of MacLeod et al. would have performed the same steps set forth in claims 12-15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacLeod et al.

MacLeod et al., as explained above, discloses the claimed invention except the use of a separate power supply for providing power to the external device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to power the external device (50) of MacLeod et al. using a separate power supply (instead of using the power supply drawn from the bus), since the Examiner takes Official Notice that it is well-known in the art that an external device (USB device, for example) can be either self-powered or bus powered; and selecting one design over the other for a specific intended use or design spec only involves routine skill in the art. If the Applicants choose to challenge the fact that it is well-known in the art that an

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external device (USB device, for example) can be either self-powered or bus powered, supportive document(s) will be provided upon request.

U.S. Patent Nos. 6,493,230 to Chidaras et al., 6,609,167 to Bastiani et al., 6,128,743 to Rothenbaum, 6,206,480 to Thompson, and 4,558,914 to Prager et al. are cited as relevant art.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.

Khanh Dang

Khanh Dang
Primary Examiner